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FEB 27 2008

OFFICE OF PETITIONS

In re Patent No. 7,268,229 :
Wood et al. : DECISION ON REQUEST
Issue Date: September 11, 2007: FOR
Application No. 10/053,482 : RECONSIDERATION OF
Filed: November 2, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 10743/3 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(d)," filed November 9, 2007. Patentees assert that the patent term adjustment pursuant to 35 U.S.C. §154(b) should be seven hundred ninety-two (792) days, instead of four hundred fifty-seven (457) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On September 11, 2007, the above-identified application matured into U.S. Patent No. 7,268,229, with a revised Patent Term Adjustment of 457 days. The instant request for reconsideration filed November 9, 2007 was timely filed within 2 months of the date the patent issued. See § 1.705(d). Patentees assert that an additional period of adjustment of 335 days should have been

entered for the Office taking in excess of three years to issue the patent, given that an RCE was filed on October 3, 2005.

Patentees' argument has been considered, but not found persuasive. Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

It is noted that this patent issued three years and 1043 days after its filing date. However, as acknowledged by patentees, a Request for Continued Examination (RCE) was filed on October 3, 2005. With respect to the filing of an RCE and the period of adjustment for the Office taking in excess of three years to issue the patent, the period of adjustment for Office delay for failure to issue a patent within three years of the actual filing date of the application will not include any time consumed by continued examination of the application under 35 U.S.C. 132(b).

Moreover, in calculating the period of adjustment, all of the time of pendency of the application after the filing of the RCE is considered consumed by continued examination requested by the application. The filing of an RCE in an application eligible for patent term adjustment cuts off the accumulation of any additional period of adjustment for Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.703(b), but does not otherwise affect the calculation of patent term adjustment. As stated in 37 CFR 1.703(b), the period of adjustment under §1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

In view thereof, the period of adjustment pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.703(b) ended with the filing in this application of an RCE on October 3, 2005. As such, the over 3-year period of adjustment is 335 days (i.e., beginning on November 3, 2004, the day after the date that is three years after the date on which this application was filed under 35 U.S.C. 111(a) and ending on October 3, 2005¹, the date an RCE was filed).

However, the period for over 3 year pendency does not as argued overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application. Patentees are incorrect in treating the relevant period as starting on November 2, 2004, the date that is 3 years after the actual filing date of the application.

Any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, it was properly concluded that the 621 days accorded pursuant to 1.703(a)(1) for Office delay during the pendency of

¹ It is noted that the calculation of this period using the date ending with the date of filing of the RCE equals the same as calculating the over 3 year period (November 3, 2004 to September 11, 2007), which is 1043 days and then subtracting the period consumed by the RCE (October 3, 2005 to September 11, 2007) which is 708 days for a calculation of (1043 - 708) 335 days.

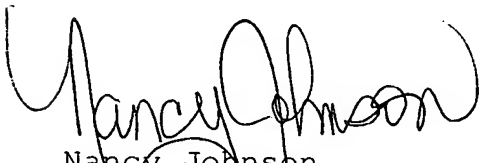
the application overlapped with the 335 days for Office delay pursuant to 37 CFR 1.703(b). Thus, no additional patent term adjustment was entered pursuant to 37 CFR 1.703(b).

Patentees do not dispute the periods of reduction totalling 164 days entered in the application. A review of these periods reveals that they are also correct.

In view thereof, the patent term adjustment of 457 days (621 - 164) indicated in the patent is correct.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions